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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/506,418

02/17/2000

Masumi Senoo

10992503-1

7752

22879

7590

04/30/2004

HEWLETT PACKARD COMPANY
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FORT COLLINS, CO 80527-2400

EXAMINER

BRINICH, STEPHEN M

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 04/30/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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Commissioner for Patents

Office Action Summary

Application No.

09/506,418

Applicant(s)

SENNO ET AL.

Examiner

Stephen M Brinich

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-24 is/are pending in the application.
- 4a) Of the above claim(s) 19-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see Paper #3, page 8, line 5 - page 12, line 8, filed 09 February 2004, with respect to the rejections of claims 1-14 under 35 USC § 102 and the rejections of claims 15-18 under 35 USC § 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, new grounds of rejection are made as set forth below.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-12 & 15-18, drawn to a print job workflow allocation system, classified in class 358, subclass 1.15.

II. Claims 19-24, drawn to a document tagging system, classified in class 358, subclass 403.

3. Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the

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instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it includes the recitation of a resource locator. The subcombination has separate utility such as a print job workflow allocation system that does not generate document tags.

4. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

5. Newly submitted claims 19-24 directed to an invention that is independent or distinct from the invention originally claimed as set forth in the above Restriction Requirement

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19-24 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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7. Claims 1-12 & 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cavill in view of Applicant's admitted Prior Art.

Re claims 1, 2, 6, & 8-9, Cavill discloses (Figure 5; column 3, line 58 - column 4, line 10; column 6, line 55 - column 7, line 8) a print job handling arrangement in which it is determined whether or not an entire print job can be processed locally. If the job cannot be processed locally, the complex portions of the print job are sent to an external server for processing and processed results are received and combined with the locally processed portions.

Cavill discloses that the locally processing of the print job is performed by a network computer (NC). Applicant's admitted Prior Art (page 1, line 23 - page 2, line 6) discloses a printer with a processor capable of performing processing of print job data within the printer. Cavill discloses (column 3, lines 36-40) that the Cavill arrangement for sending complex portions of print jobs to an external server may be used in any context where diversion of this task away from the local processor might be desirable. The use of the Cavill arrangement in this manner in conjunction with a printer with an internal print-job processor in order to enable the printer to perform print jobs that are beyond the internal processor's capability

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would be an expedient obvious to one of ordinary skill in the art.

Re claims 3, 10, & 18, Cavill discloses (column 5, lines 38-39) the use of multiple external servers for processing complex portions of a print job.

Re claims 4-5, 11-12, & 15-18, Cavill discloses (column 5, lines 5-7) the use of an Internet connection (inherently including an interface to the device at each end of the connection) to access the external server.

Re claims 7 & 14, Cavill discloses (column 1, lines 37-52) the implementation of the print job handling arrangement in the form of a program stored in a memory and executable by a processor.

Conclusion

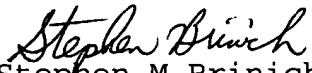
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 703-305-4390. The examiner can normally be reached on weekdays 7:00-4:30, alternate Fridays off.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center 2600 Customer Service center at 703-306-0377.

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If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 703-308-7452.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 703-872-9306.


Stephen M Brinich
Examiner
Art Unit 2624

smb
April 29, 2004